

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent application of :  
Christopher M. Rowden : Group Art Unit 2671  
Application No. 09/654,571 : Examiner Cliff N. Vo  
Filed 1 September 2000 :  
METHOD AND SYSTEM OF PRODUCING A LANDSCAPE PLAN

**REPLY BRIEF**

U.S. Patent and Trademark Office  
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Sir:

In response to the Examiner' dated 26 November 2007, twice rejecting pending claim 12, and in support of the Notice of Appeal filed on 26 March 2008, Applicants hereby submit this Reply Brief.

**Real Parties in Interest**

Christopher M. Rowden is the inventor and owns all of the rights in the above-identified U.S. patent application.

**Related Appeals and Interferences**

There are no other appeals or interferences related to this application or to any related application, nor will the disposition of this case affect, or be affected by, any other application directly or indirectly.

**Status of Claims**

Claims 1-16 and 18-21 are pending.  
Claims 1-8 and 20 are withdrawn by the Examiner

Claim 17 is canceled.

Accordingly, the claims on appeal are 9-16, 18-19 and 21.

### **Status of Amendments**

There are no pending amendments with respect to this application.

### **Summary of Claimed Subject Matter**

The present invention is directed to a process for producing a landscape plan for a property.

As broadly recited in claim 9, a process for producing a landscape plan for a property comprises: defining a set of generic plant categories according to at least one of the following plant characteristics: plant height, plant diameter, leaf texture, and whether a plant is deciduous or evergreen (FIG. 1 – 110; page 5, line 16 – page 6, line 20); assigning a symbol to each generic plant category (FIG. 1 – 120; see also FIG. 4; page 6, line 21 – page 7, line 11); determining locations for plants to be placed on the property with reference to at least one image of the property and a survey of the property (page 10, lines 19-20); and producing the landscape plan by indicating via the symbols locations for plants on the property (FIG. 1 – 150; see also FIG. 3; page 10, line 20 – page 11, line 9).

As broadly recited in claim 10, the generic plant categories are defined according to at least one of a plant height and a plant width (page 5, line 18; Table 1).

As broadly recited in claim 11, the generic plant categories are defined according to a leaf texture (page 5, line 18 – page 6, line 1; Table 1).

As broadly recited in claim 12, a process for producing a landscape plan for a property comprises: defining a set of generic plant categories according to at least one of the following plant characteristics: plant height, plant diameter, leaf texture, and whether a plant is deciduous or evergreen (FIG. 1 – 110; page 5, line 16 – page 6, line 20); assigning a symbol to each generic plant category (FIG. 1 – 120; see FIG. 4; page 6, line 21 – page 7, line 11); and producing the landscape plan by indicating via the symbols locations for plants on the property (FIG. 1 - 150; see FIG. 3; page 10, line 18

– page 11, line 9), wherein the set of generic plant categories is divided into a first subset of generic plant categories corresponding to deciduous plants, and a second subset of generic plant categories corresponding to evergreen plants (page 6, lines 1 and 17-19).

As broadly recited in claim 13, the unique symbols identify the deciduous plants and the evergreen plants (page 7, lines 7-9).

As broadly recited in claim 14, the process further comprises assigning a second set of unique symbols each corresponding to a type of hardscape material (FIG. 1 – 130; page 7, lines 12-17), wherein the landscape plan uses the second set of unique symbols to indicate hardscape materials to be used for hardscape elements indicated on the landscape plan (see FIG. 3; page 11, lines 5-9).

As broadly recited in claim 15, the landscape plan includes a legend identifying each symbol (page 11, lines 10-14; see FIG. 4).

As broadly recited in claim 16, the process further comprises providing a list of specific plants belonging to each generic plant category (page 11, line 18 – page 12, line 7).

As broadly recited in claim 18, a process for producing a landscape plan for a property comprises: defining a set of symbols, each symbol corresponding to a generic landscape element (FIG. 1 – 120, 130; see FIG. 4; page 8, lines 1-7); determining locations for specific landscape elements to be placed on the property with reference to at least one image of the property and a survey of the property; and producing the landscape plan by indicating via the symbols locations for the generic landscape elements on the property (FIG. 1 – 150; page 10, line 18 – page 11, line 2), wherein the set of symbols includes a first subset of symbols corresponding to a set of generic plant categories, and a second subset of symbols corresponding to a type of hardscape material (see FIG. 4; page 6, lines 21- page 7, line 19; page 11, lines 2-9).

As broadly recited in claim 19, the generic plant categories are defined according to at least one of the following plant characteristics: plant height, plant diameter, leaf texture, and whether a plant is deciduous or evergreen (page 5, line 16 – page 6, line 1).

As broadly recited in claim 20, the set of generic plant categories is defined according to at least one of the following plant characteristics: plant height, plant diameter, leaf texture, and whether a plant is deciduous or evergreen (page 5, line 16 – page 6, line 1).

As broadly recited in claim 21, the process further includes determining the locations for the plants to be placed on the property in accordance with a list of desired landscape characteristics for the property provided by an owner of the property (FIG. 1 – 140; page 9, lines 7-14).

### **Grounds of Rejection to be Reviewed on Appeal**

The Grounds of Rejection to be reviewed on Appeal are:

- (1) The rejections of claims 9-11 and 15-16 and 21 under 35 U.S.C. § 103 over Mykrantz U.S. Patent 5,246,253 (“Mykrantz”) in view of Lanckton et al. U.S. Patent 6,617,419 (“Lanckton”);
- (2) The rejections of claims 12 and 13 under 35 U.S.C. § 103 over Mykrantz in view of Cronquist “*An Integrated System of Flowering Plants*” (“Cronquist”);
- (3) The rejections of claims 14, 18 and 19 under 35 U.S.C. § 103 over Mykrantz in view of Brimberg U.S. Patent 4,652,239 (“Brimberg”);
- (4) The rejections of claims 9-16, 18, 19 and 21 under 35 U.S.C. § 101.

### **Arguments**

#### **(1) Claims 9-11 and 15-16 and 21 Are Patentable Over Mykrantz & Lanckton**

##### **Claim 9**

Among other things, the process of claim 9 includes determining locations for plants to be placed on a property with reference to least one image of the property and a survey of the property.

The Examiner fairly admits that Mykrantz does not disclose determining locations for plants to be placed on a property with reference to least one image of the property and a survey of the property.

The Examiner does not assert that Lanckton disclose determining locations for

plants to be placed on a property with reference to least one image of the property and a survey of the property.

However, the Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Mykrantz' garden planning kit to include such features.

Applicant respectfully disagrees.

First, Applicants respectfully submit that Lanckton does not teach the recited features.

Claim 9 recites determining locations for **plants to be placed** on a property with reference to least one image of the property and a survey of the property.

Lanckton does not teach determining locations for plants **to be placed** on a property.

Indeed, the Examiner does not even really ever bother to actually state that it does. Instead, the Examiner merely states that Lanckton teaches:

*“a system for providing precise position data of terrain features quickly and for automatically imaging those features for engineering (e.g., civil engineering) purposes and remote sensing”*

Of course, again, that is not what Applicants have claimed. In fact, it could hardly have less to do with what Applicants have claimed. There is absolutely nothing cited in the Office Action that discloses or suggests anything at all about determining any locations for plants to be placed on a property with reference to least one image of the property and a survey of the property.

So no combination of Mykrantz & Lanckton could ever produce the method of claim 9.

Second, Applicants traverse the proposed combination of Mykrantz & Lanckton as not being based on any articulated rationale with any factual underpinnings, and in fact, making absolutely no sense whatsoever.

Mykrantz is directed to a garden planning kit consisting of a worksheet having

a grid, a drawing template, overlays and adhesive decals.

Lanckton is directed to an advanced terrain mapping system including a dead-reckoning system consisting of mass attitude sensors, roll potentiometers, wheel encoders, cameras, GPS receivers, computer processors, feature extraction and recognition software, etc.

The Examiner apparently believes that one of ordinary skill in the art at the time of the invention would have sought to modify Mykrantz' garden planning kit *"to incorporate the teachings of Lanckton."*

Applicants hardly believe that this contention needs any more than a simple statement of traversal. The lack of sense of the Examiner's proposition should be apparent to the Board.

The Examiner further goes on to postulate that the reason that this modification of Mykrantz' garden kit would have been obvious is to *"allow for a more accurate and realistic looking landscape plan to be generated via the use of data gathered from the actual landscaping site itself."*

Putting aside for now the prospect of hauling Lanckton's tractor-trailer through grandma's backyard garden to help her stick adhesive stickers on Mykrantz' worksheet, Applicants note that the Examiner fails to cite anything at all anywhere in the prior art that suggests the reason he offers for the proposed modification of Mykrantz. The Examiner offers not but conclusory statements without any factual or rational underpinnings.

Meanwhile, a rejection on obviousness grounds under 35 U.S.C. § 103 cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR International Co. v. Teleflex Inc., 550 U.S. \_\_\_, 82 USPQ2d 1385, 1396 (2007) (quoting Federal Circuit statement with approval).

Therefore, Applicants respectfully submit that the proposed combination of references is improper.

**RESPONSE TO NEW ARGUMENTS IN EXAMINER'S ANSWER**

In the Examiner's Answer, the Examiner makes a number of new statements in support of the rejections of claim 9 over the proposed combination of Mykrantz & Lanckton.

At the outset, in the FINAL Office Action, the Examiner stated:

*"Mykrantz fails to explicitly teach that the determination of locations for plants to be placed is in reference to at least one image of the property and a survey of the property."*

The Examiner now clarifies that by this he does not admit that Mykrantz does not disclose any such features as "determining locations for plants to be placed on a property with reference to least one image of the property and a survey of the property." Instead, the Examiner states that Mykrantz does not all the features of "determining locations for plants to be placed on a property with reference to least one image of the property and a survey of the property." In particular, the Examiner now states that Mykrantz teaches determining locations for plants to be placed on a property. The undersigned attorney has carefully-re-read the rejection of claim 9 in the FINAL Office Action and does not see such a statement included there.

Then, the Examiner reiterates that

*"Mykrantz fails to explicitly teach that said determination of locations for plants to be placed is in reference to at least one image of the property and a survey of the property."*

The Examiner also states that Lanckton was introduced to address these limitations not taught by Mykrantz.

Applicants respectfully submit that Mykrantz does not address these limitations.

The Examiner states that Lanckton discloses producing at least one image of a property and a survey of a property.

Applicants readily concede the Lanckton (and maybe a thousand other references) disclose producing at least one image of a property and a survey of a property.

However, that is not the features of claim 9 that are missing from Mykrantz. Instead, the features of claim 9 that are missing from Mykrantz - as repeatedly admitted by the Examiner - is *“that the determination of locations for plants to be placed on a property is in reference to at least one image of the property and a survey of the property.”*

The Examiner never actually alleges that Lanckton teaches *“that the determination of locations for plants to be placed on a property is in reference to at least one image of the property and a survey of the property.”* Applicant respectfully submits that Lanckton does **not** teach *“that the determination of locations for plants to be placed on a property is in reference to at least one image of the property and a survey of the property.”*

Yet somehow, the Examiner concludes that the combination of Mykrantz which does not teach *“that the determination of locations for plants to be placed on a property is in reference to at least one image of the property and a survey of the property”* and Lanckton which also does not teach *“that the determination of locations for plants to be placed on a property is in reference to at least one image of the property and a survey of the property”* would somehow produce a method where *“the determination of locations for plants to be placed on a property is in reference to at least one image of the property and a survey of the property.”*

Applicants respectfully disagree. Indeed, because neither Mykrantz nor Lanckton discloses any method where *“the determination of locations for plants to be placed on a property is in reference to at least one image of the property and a survey of the property,”* Applicants respectfully submit that no combination of Mykrantz nor Lanckton could ever produce the method of claim 9 that includes determining locations for plants to be placed on a property with reference to at least one image of the property and a survey of a property.

Further, Applicant respectfully submits that the Examiner fails to establish that



either Lanckton or the prior art teaches or suggests that someone should modify Mykrantz' garden planning kit so that a user thereof determines locations for plants to be placed on a property in reference to at least one image of a property and a survey of a property.

The Examiner states that such a suggestion is found in both the references themselves and in knowledge generally available to one of ordinary skill in the art.

Again, Applicants respectfully disagree.

The Examiner again states that the proposed "combination" would allow a more accurate and realistic looking landscape plan to be generated via the use of highly accurate data which is gathered and processed from the actual landscaping site itself rather than using an approximation.

The Examiner does not state where or why the Examiner knows that one of skill in the art at the time the invention was made would have perceived any need or desire to modify Mykrantz' garden planning kit to generate a more accurate and realistic looking landscape plan. Nothing in Mykrantz or Lanckton discloses any such need or desire. If this is supposed to be based on some unarticulated general knowledge, the Examiner fails to explain how he is aware of such knowledge. This would appear to be the very definition of a conclusory statement without any factual basis.

Again, Lanckton is directed to an advanced terrain mapping system including a dead-reckoning system consisting of mass attitude sensors, roll potentiometers, wheel encoders, cameras, GPS receivers, computer processors, feature extraction and recognition software, etc.

Applicant respectfully submits that no one of ordinary skill in the art at the time of the invention would have sought to modify Mykrantz' garden planning kit by first hauling Lanckton's tractor-trailer through the garden to help her stick adhesive stickers on Mykrantz' worksheet.

The Examiner also states that Lanckton is directed toward attaining accurate positions of key terrain features, and that Mykrantz is directed toward accurately placing terrain features. In that case, it follows logically that Lanckton's teachings to

attain the accurate positions of key terrain features would be performed after Mykrantz was used to accurately place the terrain features in the first place (and then someone would have to use the resulting plan to actually, physically place the features from Mykrantz' plan onto the corresponding property). So there would not be any reason to modify Mykrantz such that *"the determination of locations for plants to be placed on a property is in reference to at least one image of the property and a survey of the property."*

Accordingly, for at least these reasons, Applicant respectfully submits that claim 9 is patentable over the cited art, and respectfully requests that the Board overturn the rejection of claim 9.

#### Claims 10, 11, 15 and 16

Claims 10, 11, 15 and 16 all depend from claim 9 and are deemed patentable over the cited art for at least the reasons set forth above with respect to claim 9, and for the following additional reasons.

#### Claim 16

Among other things, the process of claim 16 includes providing a list of specific plants belonging to each generic plant category.

Applicant respectfully submits that it is apparent that a sheet containing decals which have a color corresponding to a color of a particular type of plant represented cannot reasonably (or even unreasonably) be considered to "read on" a list of specific plants (e.g., "Oak," "Maple" "Poplar") belonging to a generic plant category, and the undersigned attorney believes that the Board of Patent Appeals will have absolutely no problem understanding that distinction.

### **RESPONSE TO NEW ARGUMENTS IN EXAMINER'S ANSWER**

In the Examiner's Answer, the Examiner states that the claim language fails to disclose what exactly constitutes a "list."

The Examiner fails to explain what he interprets the meaning of "list" to be or what basis (e.g., dictionary definition) he arrives at such a definition.

In any event, Applicant respectfully submits that regardless of what "list"

means, a sheet containing decals which have a color corresponding to a color of a particular type of plant represented cannot reasonably (or even unreasonably) be considered to “read on” a list of specific plants (e.g., “Oak,” “Maple” “Poplar”) belonging to a generic category. At best, assuming *arguendo* that the sheet with the decals could read on the claimed “list” the sheet would be a list of types of plants- not a list of specific plants.

The Examiner fails to address or traverse this argument. Indeed, Applicant points out that in the discussion of the rejection of claim 16 on page 17 and the top of page 18 of the Examiner’s Answer, the Examiner employs “*type[s] of [blooming] plants*” – which does not appear in claim 16 – no less than SEVEN times, but fails to even once mention the word “specific” which is clearly recited in claim 16.

Accordingly, for at least these additional reasons, Applicant respectfully request that the rejection of claim 16 be withdrawn.

#### Claim 21

Among other things, the process of claim 21 includes determining the locations for the plants to be placed on the property in accordance with a list of desired landscape characteristics for the property provided by an owner of the property.

The Examiner takes “Official Notice” that “*the concept and advantages of allowing a given owner of a property to supply input for and design a landscape plan of said property are known and expected in the art*” and that it would have been obvious to “*allow an owner of a property to utilize the method taught by Mykrantz and Lanckton et al. to supply input for and design a landscape plan for their property, because it would allow said property owner to cut out the need for a “middle-man” and would allow said owner to maintain full control over how said landscape was developed.*”

Once again, Applicant submits that this makes no sense at all.

First, what does it means for a property owner “*to supply input for and design a landscape plan?*” Is the Examiner proposing that the owner “provide input” or that the property owner “design a landscape plan?” These are two different things!

As far as a property owner “providing input,” who does the Examiner believe that the property owner would be providing this input to?? Mykrantz provides a garden planning kit for an owner to design his own garden. **There is no “middle-man” in Mykrantz.** There is only one man (or woman) – the person designing their garden. The Examiner is attempting to add a second person to Mykrantz process by having the owner “provide input.” Why? How is modifying Mykrantz so that a property owner “provides input” to someone going to produce a “*more efficient and cost effective process*” as alleged by the Examiner. Why would anyone modify Mykrantz process so that it would “determine the locations for the plants to be placed on the property in accordance with a list of desired landscape characteristics for the property **provided by** an owner of the property.”

As far as a property owner “designing [his/her own] landscape plan” – that is not what claim 21 claims. Why and how would a property owner who is designing his own garden using Mykrantz’ garden planning kit “determine the locations for the plants to be placed on the property in accordance with a list of desired landscape characteristics for the property **provided by** an owner of the property?” That makes no sense. Furthermore, since Mykrantz is all about a garden planning kit for someone to design their own garden. So again, exactly what “middle-man” is supposedly being cut out by modifying Mykrantz to include this feature?

Finally, even if the proposed modification of Mykrantz made any sense at all, the Examiner once again fails to provide a proper foundation for his proposed reason for the modification. The examiner offers nothing but conclusory statements of alleged benefits and advantages without any evidence thereof, or that such alleged benefits and advantages would have been known or recognized by one of ordinary skill in the art at the time the invention was made.

#### **RESPONSE TO NEW ARGUMENTS IN EXAMINER’S ANSWER**

In the Examiner’s Answer, the Examiner states that Applicants did not adequately traverse the Official Notice,

Applicants did not traverse the statement that “*the concept and advantages of*

*allowing a given owner of a property to supply input for and design a landscape plan of said property are known and expected in the art.”*

Instead, Applicants submit that the statement is irrelevant to the patentability of claim 21.

Applicants did and do specifically traverse the statement that it would have been obvious to “*allow an owner of a property to utilize the method taught by Mykrantz and Lanckton et al. to supply input for and design a landscape plan for their property, because it would allow said property owner to cut out the need for a “middle-man” and would allow said owner to maintain full control over how said landscape was developed.*”

At the outset, Applicant submits that there is no such thing as “*the method taught by Mykrantz and Lanckton et al.*”

Second, there is no “middle-man” in Mykrantz’ process that needs to be eliminated. In Mykrantz, a person uses the garden planning kit and produces a plan for the garden without any such “middle-man.”

To this, the Examiner replies that the middle-man includes, for example, a hired landscaper.

The Examiner fails to explain where either Mykrantz or Lanckton discloses any such a hired landscaper.

It appears to Applicant that the Examiner has conjured a hired landscaper out of thin air so that the Examiner can then turn around and state that someone would want to modify Mykrantz and Lanckton to eliminate the non-existent hired landscaper that the Examiner just conjured up!

Surely such “reasoning” cannot be the articulated reasoning with some rational underpinning that the federal Circuit required in KSR.

Accordingly, for at least these additional reasons, Applicant respectfully request that the rejection of claim 21 be withdrawn.

**(2) Claims 12 and 13 Are Patentable Over Mykrantz & Cronquist**

Among other things, in the processes of claims 12 and 13, a set of generic plant

categories is divided into a first subset of generic plant categories corresponding to deciduous plants, and a second subset of generic plant categories corresponding to evergreen plants.

The Examiner admits that Mykrantz does not disclose or suggest any such features.

However, the Examiner cites Cronquist for supplying these missing features, and states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Mykrantz' garden planning kit to include such features.

Applicant respectfully disagrees.

Cronquist merely teaches that plants can be classified as deciduous or evergreen.

Applicants concede that it is known that plants can be classified as deciduous or evergreen. The Examiner hardly needs to cite Cronquist for that knowledge it is commonly taught to grade school students.

Applicants have not claimed to have discovered this.

Instead, Applicants have claimed a specific process of producing a landscape plan by defining a set of generic plant categories according to at least one a variety of characteristics and dividing the generic plant categories into a first subset of generic plant categories corresponding to deciduous plants, and a second subset of generic plant categories corresponding to evergreen plants.

As noted above, Mykrantz does not disclose dividing generic plant categories into a first subset of generic plant categories corresponding to deciduous plants, and a second subset of generic plant categories corresponding to evergreen plants.

The Examiner states that it would have been obvious to have modified Mykrantz to include these features *"to provide an easier to understand classification of plants that either lose or maintain their leaves seasonally."* That is tautological – in effect arguing that it would have been obvious to have modified Mykrantz to include the recited features . . . so that Mykrantz would include the recited features! This cannot possibly meet the standard of analysis for a rejection under 35 U.S.C. § 103

required by KSR cited above.

The Examiner also states that this would provide a user of Mykrantz system “with more options which would allow them to plan out a landscape design with a greater degree of detail and accuracy.”

Again, the Examiner offers conclusory statements which cannot support a rejection under 35 U.S.C. § 103.

### **RESPONSE TO NEW ARGUMENTS IN EXAMINER’S ANSWER**

In the Examiner’s Answer, the Examiner states that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Applicants agree and are aware of that.

However, the Examiner has failed to actually point to anything in the prior art of knowledge generally available to one of ordinary skill in the art that actually teaches or suggests the proposed modification of Mykrantz. Instead, the Examiner has merely pointed out that the plants can be classified as deciduous or evergreen.

Accordingly, for at least these reasons, Applicant respectfully submits that claims 12 and 13 are patentable over the cited art, and respectfully requests that the Board overturn the rejection of claims 12 and 13.

### **(3) Claims 14, 18 and 19 Are Patentable Over Mykrantz, Lanckton & Brimberg**

#### **Claim 14**

Claim 14 depends from claim 9. Applicant respectfully submits that Brimberg does not remedy the shortcoming of Mykrantz and Lanckton as set forth above with respect to claim 9, and accordingly, claim 14 is deemed patentable for at least the reasons set forth above with respect to claim 9.

#### **Claim 18**

Among other things, the process of claim 18 includes determining locations for

specific landscape elements to be placed on a property with reference to least one image of the property and a survey of the property

For similar reasons to those set forth above with respect to claim 9, Applicant respectfully submits that the cited art does not disclose or suggest these features.

Accordingly, for at least these reasons, Applicant respectfully submits that claim 18 is patentable over the cited art.

Claim 19

Claim 19 depends from claim 18 and is deemed patentable over the cited art for at least the reasons set forth above with respect to claim 18.

**(4) Claims 9-16, 18, 19 and 21 Are Patentable Under 35 U.S.C. § 101**

The Examiner's Answer includes a designated new ground of rejection for claims 9-16, 18, 19 and 21. In particular, the Examiner's Answer rejects claims 9-16, 18, 19 and 21 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Applicant respectfully traverses these rejections for at least the following reasons.

The Examiner's Answer states that:

*"Supreme Court precedent and recent federal Circuit decisions indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing"*

citing: Diamond v. Diehr, 450 U.S. 175, 184 (1981) (hereinafter "Diehr"); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978) (hereinafter "Flook"); Gottschalk v. Benson, 409 U.S. 63, 70 (1972) (hereinafter "Benson"); and In re Bilski, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008) (hereinafter "Bilski").

Applicant respectfully disagrees. Applicant respectfully submits that applying



such a test to Applicants' claims is not dictated by Bilski, and to the extent that language in Bilski does impose such a test, that test is in error and in contradiction to established precedent of the U.S. Supreme Court.

In Bilski, the Federal Circuit stated that “[th]e true issue before us then is whether Applicants are seeking to claim a fundamental principle (such as an abstract idea) or a mental process.” Bilski 545 F.3d at 952. Bilski further defined “fundamental principles” as laws of nature, natural phenomena, and abstract ideas. Id at n. 5.

Here, Applicants have claimed a process for producing a landscape plan. Neither the claimed process, nor the landscape plan, is a law of nature, natural phenomenon, abstract idea or mental process.

Meanwhile, in Diehr, in upholding the method claims at issue, the U.S. Supreme Court reviewed the Benson and Flook cases and stated:

“This Court has undoubtedly recognized limits to § 101, and every discovery is not embraced within the statutory terms. Excluded from such patent protection are laws of nature, natural phenomena, and abstract ideas. See Parker v. Flook, 437 U. S. 584 (1978); Gottschalk v. Benson, *supra* at 409 U. S. 67; Funk Bros. Seed Co. v. Kalo Inoculant Co., 333 U. S. 127, 333 U. S. 130 (1948). ‘An idea of itself is not patentable,’ 87 U. S. 507 (1874). ‘A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.’ 55 U. S. 175 (1853).”

Diehr 450 U. S. at 185.

Thus, the only limits or exclusions to § 101 articulated by the Court in Diehr are laws of nature, natural phenomena, and abstract ideas. Here, Applicants have not claimed any laws of nature, natural phenomena, or abstract ideas.

Furthermore, the very “bright lines” test articulated in the Examiner’s Answer has already been specifically twice rejected by the U.S. Supreme Court.

“It is argued that a process patent must either be tied to a particular machine or apparatus or must operate to change articles or materials to a ‘different state or thing.’ We do not hold that no process patent could ever qualify if it did not meet the requirements of our prior precedents.”

Benson 409 U.S. at 71.

“As in Benson, we assume that a valid process patent may issue even if it does not meet one of these qualifications of our earlier precedents.”

Flook 437 U.S. at 588 n. 9.

To the extent that Bilski states otherwise, Applicants respectfully submit that Bilski is in opposition to the precedent of the U.S. Supreme Court as articulated in Benson and reiterated in Flook. At the time that this Reply Brief is being filed, the applicant in Bilski has petitioned the U.S. Supreme Court for a writ of certiorari to review the decision of the Federal Circuit. The undersigned attorney believes that the Supreme Court will clarify the law in this matter and correct the errors that appear in the Bilski decision.

The Examiner’s Answer also states that:

*“the instant claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplished the claimed method steps, and therefore do not qualify as a statutory process.”*

Again, Applicant respectfully disagrees. Applicants respectfully submit that 9-16, 18, 19 and 21 all transform underlying subject matter.

In Bilski, the Federal Circuit specifically stated that:

*“So long as the claimed process is limited to a practical application of a fundamental principle to transform specific data, and the claim is limited to a visual depiction that represents physical objects or substances, there is no danger that the scope of the claim would wholly pre-empt all uses of the principle.”*

Bilski 545 F.3d at 963.

Here, claims 9-11, 14-16, 18, 19 and 21 are all specifically limited to a practical application *“producing a landscape plan for a property”* that transforms specific data *“at least one image of said property and a survey of said property”* to a visual depiction *“a landscape plan”* that represents specific physical objects or substances *“indicating via said symbols locations for said plants on said property.”*

Meanwhile, claims 12 and 13 are also specifically limited to a practical application *“producing a landscape plan for a property”* that transforms specific data *“assigning a symbol to each generic plant category”* to a visual depiction *“a landscape plan”* that represents specific physical objects or substances *“indicating via said symbols locations for said plants on said property.”*

Finally, the Examiner’s answer states that the processes of claims 9-16, 18, 19 and 21 *“would be reasonably interpreted as a series of steps completely performed mentally, verbally, or without a machine.”*

Applicant respectfully disagrees that the processes of claims 9-16, 18, 19 and *“would be reasonably interpreted as a series of steps completely performed mentally [or] verbally.”* Claims 9-16 and 21 all specifically include: *“producing the landscape plan by indicating via said symbols locations for said plants on said property.”* Similarly, claims 18 and 19 specifically include *“producing the landscape plan by indicating via said symbols locations for the specific landscape elements on said property.”* The landscape plan is a definite article (see, e.g., Applicant’s specification at page 12, lines 17-19), and each of the above-recited steps producing it **cannot** be completely performed mentally or verbally or without a machine.

Indeed, the specification of this patent application clearly and specifically

defines “Landscape plans” as “design drawings.” Applicant’s Specification at page 1, lines 11-12. FIG. 3 of Applicant’s specification shows an exemplary landscape plan. Applicants respectfully submit that it is self-evident that a process that specifically recites in the bodies of the claims producing such a landscape plan (i.e., “producing design drawings”) cannot possibly be “*completely performed mentally, verbally, or without a machine*.” Some physical apparatus (broadly “machine”) is required to produce the landscape plan. In some embodiments the apparatus (“machine”) might include one or more of the following: a computer, a display device, a printer, a sheet of paper, a writing implement, a template, pre-printed stickers, etc. But in all cases, some physical apparatus is required to produce a landscape plan.

Accordingly, for at least these reasons, Applicant respectfully submits that claims 9-16, 18, 19 and 21 are define patentable subject matter under 35 U.S.C. § 101.

### **CONCLUSION**

In view of the foregoing explanations, Applicant respectfully requests that the Board reverse the rejections of claims 9-16, 18-19 and 21, and pass the application to issue. If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 50-0238 for any additional fees required under 37 C.F.R. § 1.16, 37 C.F.R. § 1.17, and/or 37 C.F.R. § 41.20, particularly extension of time fees.

Respectfully submitted,

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**Appendix - Claims on Appeal**

1. (Withdrawn) A process for producing a landscape plan for a real property, comprising:

defining a set of generic plant categories;

assigning a corresponding unique symbol to each generic plant category, defining a set of unique symbols;

communicating from a first party to a second party a survey of the real property, a photograph of the real property, and a list of desired landscape characteristics for the real property; and

the second party generating the landscape plan for the real property, the landscape plan using the unique symbols to indicate locations on the real property where plants should be located.

2. (Withdrawn) The process of claim 1, wherein the generic plant categories are defined according to a plant size.

3. (Withdrawn) A process for producing a landscape plan for a property, comprising:

defining a set of generic plant categories;

assigning a corresponding unique symbol to each generic plant category, defining a set of unique symbols;

receiving from a customer a survey of the property, a photograph of the property, and a list of desired landscape characteristics for the property; and generating the landscape plan for the property, the landscape plan using the unique symbols to indicate locations on the property where plants should be located, wherein the generic plant categories are defined according to a plant size and a leaf texture.

4. (Withdrawn) The process of claim 1, wherein the set of generic plant categories is divided into a first subset of generic plant categories corresponding to deciduous plants, and a second subset of generic plant categories corresponding to evergreen plants.

5. (Withdrawn) The process of claim 4, wherein the unique symbols identify the deciduous plants and the evergreen plants.

6. (Withdrawn) The process of claim 1, further comprising assigning a second set of unique symbols each corresponding to a type of hardscape material, wherein the landscape plan uses the second set of unique symbols to indicate hardscape materials to be used for hardscape elements indicated on the landscape plan.

7. (Withdrawn) The process of claim 1, wherein the landscape plan includes a legend identifying each symbol.

8. (Withdrawn) The process of claim 1, further comprising providing a list of specific plants belonging to each generic plant category.

9. (Previously Presented) A process for producing a landscape plan for a property, comprising:

defining a set of generic plant categories according to at least one of the following plant characteristics: plant height, plant diameter, leaf texture, and whether a plant is deciduous or evergreen;

assigning a symbol to each generic plant category;

determining locations for plants to be placed on said property with reference to at least one image of said property and a survey of said property; and

producing the landscape plan by indicating via said symbols locations for said plants on said property.

10. (Previously Presented) The process of claim 9, wherein the generic plant categories are defined according to at least one of a plant height and a plant width.

11. (Original) The process of claim 10, wherein the generic plant categories are defined according to a leaf texture.

12. (Previously Presented) A process for producing a landscape plan for a property, comprising:

defining a set of generic plant categories according to at least one of the following plant characteristics: plant height, plant diameter, leaf texture, and whether a plant is deciduous or evergreen;

assigning a symbol to each generic plant category; and

producing the landscape plan by indicating via said symbols locations for plants on said property,

wherein the set of generic plant categories is divided into a first subset of generic plant categories corresponding to deciduous plants, and a second subset of generic plant categories corresponding to evergreen plants.

13. (Original) The process of claim 12, wherein the unique symbols identify the deciduous plants and the evergreen plants.

14. (Original) The process of claim 9, further comprising assigning a second set of unique symbols each corresponding to a type of hardscape material, wherein the landscape plan uses the second set of unique symbols to indicate hardscape materials to be used for hardscape elements indicated on the landscape plan.

15. (Original) The process of claim 9, wherein the landscape plan includes a legend identifying each symbol.

16. (Original) The process of claim 9, further comprising providing a list of

specific plants belonging to each generic plant category.

17. (Canceled).

18. (Previously Presented) A process for producing a landscape plan for a property, comprising:

defining a set of symbols, each symbol corresponding to a generic landscape element;

determining locations for specific landscape elements to be placed on said property with reference to at least one image of said property and a survey of said property; and

producing the landscape plan by indicating via said symbols locations for the specific landscape elements on said property,

wherein the set of symbols includes a first subset of symbols corresponding to a set of generic plant categories, and a second subset of symbols corresponding to a type of hardscape material.

19. (Previously Presented) The process of claim 18, wherein the generic plant categories are defined according to at least one of the following plant characteristics: plant height, plant diameter, leaf texture, and whether a plant is deciduous or evergreen.

20. (Withdrawn) The process of claim 1, wherein the set of generic plant categories is defined according to at least one of the following plant characteristics: plant height, plant diameter, leaf texture, and whether a plant is deciduous or evergreen.

21. (Previously Presented) The method of claim 9, further comprising determining the locations for said plants to be placed on said property in accordance with a list of desired landscape characteristics for the property provided by an owner



of the property.

**Evidence Appendix**

{None}

**Related Proceedings Appendix**

{None}